THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 39

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

Ex parte SUMITOMO ELECTRIC IND. LTD.

_____

Appeal No. 98-1843
Reexamination No. 90/003,799[1]

_____

Before GARRIS, WEIFFENBACH and WALTZ, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

ON REQUEST FOR REHEARING

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[1] Reexamination proceeding requested April 21, 1995, of U.S. Patent No. 4,468,435, issued August 28, 1984, based on Application 06/279,400, filed July 1, 1981. According to appellant, this application is a continuation of Application 06/073,475, filed September 7, 1979; which is a continuation of Application 05/858,752, filed December 8, 1977; which is a continuation of Application 05/661,876, filed February 27, 1977; which is a division of Application 05/420,486, filed November 30, 1973; all of which are abandoned.

This is in response to a Request for Reconsideration (i.e., Rehearing) of our Decision mailed September 25, 1998 wherein we affirmed the examiner's decision rejecting the appealed claims under 35 U.S.C. § 103 as being unpatentable over the prior art which includes Boysen as a primary reference. The file record for this reexamination proceeding reflects that the Request for Reconsideration was filed November 25, 1998 and included a Request for Remand to the Examiner as well as an unexecuted Declaration under 37 CFR 1.132. Subsequently, on December 1, 1998, an executed copy of the aforementioned Declaration was filed which included a change on page 3 thereof, and, on December 17, 1998, a supplemental Declaration under 37 CFR 1.132 was filed in order to submit a corrected Table I which remediated an error in the original Table I of the previously noted § 1.132 executed as well as unexecuted Declarations.

In the reconsideration request, it is the appellant's basic position that the Board erred in analyzing and relying upon Boysen as a primary reference. On the first page of this request, the appellant expresses this basic position as

follows:

> For the reasons advanced below, SEI [i.e., the appellant] submits that the Board is incorrect in its analysis of the reasonable teaching of Boysen to one of ordinary skill in the art at the time of the present invention, and thus the Board erred in relying upon Boysen as a primary reference in combination with the secondary references relied upon. This is because Boysen substantially does not disclose a foaming ratio in excess of 2.5 times as set forth in the attached [unexecuted] DECLARATION UNDER 37 C.F.R. § 1.132 (hereafter the 132 Declaration) filed herewith. An executed copy is being forwarded from Japan and will shortly be filed.

In addition, the appellant "requests a remand to the Examiner so that the Examiner may consider the attached 132 Declaration" (Request, 6th page).

In response to the appellant's above noted requests: (1) we do not agree that we erred in analyzing and relying upon Boysen as a primary reference; (2) we will not remand this application to the examiner for consideration of the § 1.132 Declaration(s) proffered by the appellant subsequent to our decision in connection with the subject requests; and (3) we will not consider sua sponte these Declaration(s). Our reasons follow.

The remand request will not be granted because it is not

the custom of the Board to remand declarations offered in connection with a request for reconsideration/rehearing of its Decision where no rejection has been made under 37 CFR 1.196(b). See the Manual of Patent Examining Procedure (M.P.E.P.) § 1211.02 (July 1998). With respect to this last mentioned point concerning § 1.196(b), the appellant contends that the "extremely strict approach taken by the Board [at lines 10-15 on page 15 of our Decision[2]] amounts, in essence, to a new ground of rejection" (Request, 6th page). This contention is quite plainly incorrect.

In the first place, it is inappropriate for the appellant to consider the burden of proof discussion in the paragraph bridging pages 14 and 15 of our Decision as an "an extremely strict approach taken by the Board." Rather, the burden of proof discussed in this paragraph is a well established requirement of law, and its fairness is evidenced by the

[2] We there stated that "it is the appellant's burden to show that Boysen's process of using a gaseous blowing agent will not produce the post-foaming densities (and the concomitant foaming ratios) expressly taught by patentee, and this burden of proof has not been even shouldered much less carried on the record before us."

inability of the Patent and Trademark Office to manufacture products or to obtain and compare prior art products. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-434 (CCPA 1977). Furthermore, notwithstanding the appellant's apparent belief to the contrary, the examiner repeatedly has expressed the position in his Office actions and in his Answer that he regards Boysen to teach foaming ratios within the appealed claim range (e.g., see the paragraph bridging pages 4 and 5 of the Answer). Under these circumstances, we believe the appellant has had ample notice of, and opportunity to carry, his aforementioned burden. Particularly when viewed from this perspective, it is clear that the observation in our decision of the appellant's failure to even shoulder much less carry his burden cannot be reasonably considered (as the appellant has done) to amount ",in essence, to a new ground of rejection."

In addition to the foregoing, we point out that "Cases which have been decided by the Board of Patent Appeals and Interferences will not be reopened or reconsidered by the primary examiner except under the provisions of §1.196 without the written authority of the Commissioner, and then only for

the consideration of matters not already adjudicated, sufficient cause being shown"; 37 CFR § 1.198 (1985). The record before us contains no indication of an attempt by the appellant to request invocation of the Commissioner's authority on this matter in accordance with the guidelines set forth in M.P.E.P. § 1214.07 (July 1998).

For the above stated reasons, we will not grant the subject request for remand to the examiner so that he may consider the
§ 1.132 Declaration(s) proffered by the appellant.

For analogous reasons, we will not sua sponte consider these Declaration(s). It is well settled that the Board is within its authority to reject a belated offer of evidence made in an appellant's request for reconsideration under the circumstances at issue here. In re Fessmann, 489 F.2d 742, 745, 180 USPQ 324, 326 (CCPA 1974). Also see In re Melchiore, 406 F.2d 1079, 1080 n.6, 160 USPQ 672, 673 n.6 (CCPA 1969). At best, the appellant's Declaration(s) can be regarded only as arguments and not as proofs. In re Martin, 154 F.2d 126, 129, 69 USPQ 75, 77-78 (CCPA 1946); M.P.E.P. § 1211.02, id..

With respect to such arguments, we continue to regard

them as unconvincing of the appellant's position that Boysen contains no teaching or suggestion of the foaming ratios claimed by the appellant. Our reasons for remaining unconvinced constitute those fully detailed in our decision.

In light of the foregoing, the appellant's subject request is granted to the extent that our decision has been reconsidered/reheard but is denied in all other respects.

DENIED

BRADLEY R. GARRIS Administrative Patent Judge	)	
CAMERON WEIFFENBACH Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
THOMAS A. WALTZ Administrative Patent Judge	)	

bae

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